

REMARKS

Claims 80-86, 89-98, 101-110 and 113-116 are pending in the application. Claims 80, 92, 104 and 116 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 80, 81, 92, 93, 95, 104 and 105 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Paltenghe (U.S. Pat. Pub. No. 2001/0011250A1). Claims 82-86, 89-91, 94, 96-98, 101-103, 106-110 and 113-115 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Paltenghe in view of Meyers (U.S. Pat. No. 6,915,271 B1).¹ Applicants respectfully traverse these rejections and submit that the above amendments further place the claims in condition for allowance.

Current Amendments to the Claims

Applicants have amended claims 80, 92, 104 and 116 as shown above to reflect existing antecedent bases and to more fully recite the features of an “item” and a “buy decision”. With reference to the amendment relative to the “buy decision,” Applicants note that the specification defines the term on page 14, lines 18-20 (“the data subject is presented with a buy decision . . . the data subject can elect to buy the item, change the data subject’s information and buy the item, or cancel the transaction”). Notwithstanding this definition, in the present Office Action, the Examiner has interpreted the term “buy decision” so broadly as to be inconsistent with the definition which Applicants are using as their own lexicographers.

Applicants submit that, because the amendment with respect to the term “buy decision” does no more than to repeat the definition which Applicants provided for that term in the specification, this amendment does not change the scope of the claims.

¹ Since claim 116 “is rejected on the same grounds as claim 80” (Office Action, p. 11), Applicants assume that claim 116 is rejected under 35 U.S.C. § 102(e) as being anticipated by Paltenghe. Similarly, since claim 95 “is rejected on the same grounds as claim 83,” and since claim 83 depends on claim 82, Applicants respectfully submit that claim 95 is more properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Paltenghe in view of Meyers.

Support for the other amendments may be found at least on page 11, line 25-page 12, line 2 (“[t]he authorized data recipient’s offer includes the following information . . . price of the item”), and page 15, lines 12-13 (“if the data subject elects to purchase the item, then the information regarding the transaction is delivered to the authorized data recipient’s computer”). No new matter has been added.

Claim Rejections – 35 U.S.C. § 112

In response to the Examiner’s assertion that “it is not possible to determine the scope of the claim” as requiring one, two, or three “items” (Office Action, p. 4), it appears that the Examiner Applicants respectfully submit that claims 80, 92, 104 and 116 clearly define the “item” as the item to be purchased. For example, claim 80 recites a “method for allowing a data subject to purchase an item,” claim 92 recites a “computer readable medium including instructions . . . to allow a data subject to purchase an item,” and claim 104 recites a “system for purchasing an item.” Nevertheless, Applicants have amended claims 80, 92, 104 and 116 to more clearly indicate that the “item” is the item to be purchased. Applicants therefore respectfully request that the Examiner reconsider and withdraw his rejections under 35 U.S.C. § 112.

Claim Rejections – 35 U.S.C. § 102

As previously noted, the present application defines “buy decision” on page 14, lines 17-20 (emphasis added):

Once the data subject enters a correct passphrase or if there was no browser identifier for the data subject, the data subject is presented with a buy decision 248. The data subject has several options available at this step: the data subject can elect to buy the item, change the data subject’s information and buy the item, or cancel the transaction.

While Applicants disagree with the Examiner’s overly broad interpretation of “buy decision,” the amendments to the independent claims insert Applicants’ definition from the specification. Applicants do not believe this amendment to be necessary, since Applicants have acted as their own lexicographer. Applicants also do not believe that this amendment changes

the scope of the claims, because the definition is merely the one which Applicants provided in the specification. In any event, each of the independent claims now specifies that the buy decision “present[s] a choice between purchasing [an] item, changing the purchasing information [associated with a data subject/purchaser], and declining to purchase the item” (emphasis added).

Paltenghe lacks the “buy decision” of the present application because Paltenghe does not teach the option to change the data subject’s information. Even if the “consumer has the opportunity to request a purchase” or “can elect to purchase, as in paragraph 0061” (Office Action p. 3), Paltenghe does not teach presenting the data subject with the option to modify his or her information after receiving an offer from the merchant.

Meyer does not remedy—nor is it asserted to remedy—this deficiency in Paltenghe. Thus, for at least this reason, Applicants respectfully request reconsideration and withdrawal of all rejections under 35 U.S.C. § 102.

Claim Rejections – 35 U.S.C. § 103

Since Paltenghe, alone or in combination with Meyer, does not teach or suggest independent claims 80, 92, 104 and 116 of the present application, and since claims 81-86, 89-91, 93-98, 101-103, 105-110 and 113-115 depend on claims 80, 92 and 104, the independent claims are also patentable for at least the reasons discussed above.

Moreover, with respect to the independent claims, Applicants again note that Paltenghe repeatedly teaches away from the current application’s limitation wherein the data repository sends purchase transaction information to the data recipient. In the Remarks submitted with the previous Amendment (in connection with the RCE), Applicants rebutted the Examiner’s reliance on *In re Oetiker* (see RCE Amendment, p. 12). The Examiner has not responded to Applicants’ rebuttal, nor has the Examiner actually responded to any of the arguments on pp. 12-14 of the RCE amendment as to why Paltenghe teaches away from the claimed invention. Applicants refer again to those arguments, and respectfully request that, if the Examiner is going to maintain this rejection, the Examiner respond to these arguments. Moreover, Applicants submit that, if the Examiner does maintain this rejection and now responds to Applicants’ arguments, the Office Action containing that rebuttal cannot properly be made final, because the issue would not yet

have been joined – Applicants would not have had an opportunity, until such point, to address the Examiner's position, and no amendment of Applicants would have necessitated such rebuttal.

For at least these reasons, in addition to their dependence on claims 80, 92 and 104, claims 82-86, 94-98 and 106-110 are patentable over Paltenghe in view of Meyers. Applicants therefore respectfully request reconsideration and withdrawal of all rejections under 35 U.S.C. 103(a).

Request for Allowance

It is believed that this amendment places the application in condition for allowance, and early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

The Office is hereby authorized to charge any fees, or credit any overpayments, to Deposit Account No. **11-0600**.

Respectfully submitted,
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